

Notice of Allowability

Application No.

08/479,997

Examiner

John S. Brusca

Applicant(s)

ENGELHARDT ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Appeal Brief filed 04 April 2005.
2. ☒ The allowed claim(s) is/are 956-961, 964-968, 970-976, 978-993, 996-1000, 1002-1009, 1011-1027, 1030-1034, 1036-1042, 1044-1059, 1062-1066, 1068-1075 and 1077-1087.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 3/15/2002
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert Schulman on 14 September 2005.

The application has been amended as follows:

In claim 956, line 12, before the phrase "chemical linkage" the term --non-nucleotidyl-- has been inserted.

In claim 956, line 13, after the phrase "a non-polypeptide," the term --non-nucleotidyl-- has been inserted.

In claim 956, lines 19-20, after the phrase "a chromogenic component," the term --a hapten,-- has been inserted.

In claim 988, line 20, before the phrase "chemical linkage" the term --non-nucleotidyl-- has been inserted.

In claim 988, line 22, after the phrase "a non-polypeptide," the term --non-nucleotidyl-- has been inserted.

In claim 988, lines 28-29, after the phrase "a chromogenic component," the term --a hapten,-- has been inserted.

In claim 1022, line 12, before the phrase "chemical linkage" the term --non-nucleotidyl-- has been inserted.

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In claim 1022, lines 12-13, after the phrase “a non-polypeptide,” the term --non-nucleotidyl-- has been inserted.

In claim 1022, line 24, after the phrase “a chromogenic component,” the term --a hapten,- has been inserted.

In claim 1054, line 20, before the phrase “chemical linkage” the term --non-nucleotidyl-- has been inserted.

In claim 1054, line 22, after the phrase “a non-polypeptide,” the term --non-nucleotidyl-- has been inserted.

In claim 1054, lines 33-34, after the phrase “a chromogenic component,” the term --a hapten,-- has been inserted.

2. The following is an examiner's statement of reasons for allowance: The claims have been amended to make explicit the applicant's contention in the Appeal Brief filed 04 April 2005 that the claims do not read on the cited prior art of Hartman et al, which shows polynucleotides with label groups attached to the base of the polynucleotide. All rejections under 35 U.S.C. 102(b) and 102(a) have been withdrawn in view of the arguments presented in the Appeal Brief filed 04 April 2005 and the Examiner's amendment detailed above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

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3. A review of the application file shows that a signed copy of list of references accompanying the Information Disclosure Statement filed 15 March 2001 was not present. A signed copy of the list of references indicating that all listed references have been considered is attached to this Office action.

4. The application file shows an Information Disclosure Statement cover letter filed on 06 August 2002, but no list of references or copies of references associated with that paper. As such no references filed with the cover letter have been considered.

Conclusion

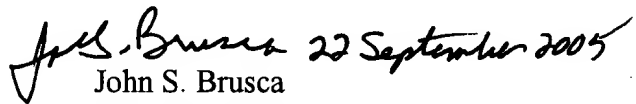
5. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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For all other customer support, please call the USPTO Call Center at (800) 786-9199. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD. can be reached on 571 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 22 September 2005
John S. Brusca
Primary Examiner
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jsb